Remarks

Claims 1, 3, 5, 10, 12, and 14 are pending.

Objections to the Claims

Claims 10, 12 and 14 were objected to under 37 CFR 1.75 as being substantial duplicates of claims 1, 3 and 5. Applicants respectfully traverse.

As stated in the M.P.E.P. at §706.03(k), court decisions have confirmed an applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. A mere difference in scope between the claims is enough. Applicants respectfully submit that the claims towards the nucleic acid sequence of Figure 31 are different in scope from the claims reciting the pVGI.1 vector.

Even though Brief Description of the Figures states that "Figure 31A-G shows the nucleotide sequence of the pVGI.1 vector construct containing the VEGF-2 insert," the claims directed towards the pVGI.1 vector (i.e., claims 10, 12 and 14) are not ***necessarily*** identical to the claims directed towards the nucleic acid sequence of Figure 31 (i.e., claims 1, 3 and 5). For example, the nucleotide sequence depicted in Figure 31 ***may*** contain sequence differences when compared to the pVGI.1 vector. The differences between the sequence of Figure 31 and the deposited vector and could be due, for example, to a sequencing error made when generating the nucleotide sequence or a typographical error made when generating Figure 31. Applicants therefore request withdrawal of this objection.

Rejections under 35 U.S.C. §102(a) and §103

Claims 1, 5, 10 and 14 were rejected under 35 U.S.C. § 102(a) as anticipated by Vale et al. Claims 3 and 12 were rejected under 35 U.S.C. §103(a) as unpatentable over Vale et al., in view of Manniatis et al. Applicants respectfully traverse.

Contrary to the Examiner's assertion, it is not relevant whether or not the pVGI.1 vector disclosed in the cited reference is the same vector as claimed. The relevant inquiry is whether or not the cited reference **enables** the claimed invention.

The Federal Circuit held in *In re Donohue,* that a § 102(b) reference "must sufficiently describe the claimed invention to have **placed the public in possession of it**." *In re Donohue,* 776 F.2d 531, 533 (Fed. Cir. 1985), citing *In re Sasse,* 629 F.2d 675, 681 (CCPA 1980) and *In re Samour,* 571 F.2d 559, 562 (CCPA 1978) [Emphasis added]. Additionally, the court

observed in *Donohue* that "**even if the claimed invention is disclosed in a printed publication**, that disclosure will not suffice as prior art if it was not enabling." *Id.* (citing *In re Borst,* 345 F.2d 851, 855 (CCPA 1965) *cert. denied,* 382 U.S. 973 (1966) ("the disclosure must be such as will **give possession of the invention to the person of ordinary skill**")). [Emphasis added]

Because the Vale et al reference does not provide the nucleic acid sequence of the pVGI.1 vector or provide any indication of the elements (other than the VEGF-2 gene) that are present in the claimed vector construct, the Vale et al. reference does not **place the public in possession** of the claimed invention, **even if the claimed invention is disclosed**. Therefore, the Vale et al. reference is not an anticipatory reference. Applicants therefore request withdrawal of this rejection.

The Manniatis et al. reference does not remedy the deficiencies of the Vale et al. reference. Therefore, the rejection under 35 U.S.C. §103(a) is also improper. Applicants similarly request withdrawal of this rejection.

Conclusion

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

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Respectfully submitted,

By _____

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